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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/013,541	01/26/98	LINNARTZ J	PHN16210

EXAMINER	
MEISLAHN D	
ART UNIT	**PAPER NUMBER**
2132	21

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DATE MAILED: 01/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/013,541	Linnartz
Examiner	**Group Art Unit**
Douglas Meislahn	2132

☒ Responsive to communication(s) filed on *Nov 6, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-19* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-19* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 06 November 2000 that amended claims 1-3, 5-7, 11, and 13-18 and added claim 19.

Response to Arguments

2. Applicant's arguments filed 06 November 2000 with respect to the 101 rejection have been fully considered but they are not persuasive. Contrary to applicant's comments, a bitpattern does not necessarily cause a processor to carry out a process. Hence it is not a data structure. Please read the case law cited in the previous office action.

3. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 6 recites the limitation "the generating means" in the fourth line of the claim. There is insufficient antecedent basis for this limitation in the claim. Add "generating" to the first means of claim 5.

7. Claim 7 recites the limitation "the seed" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim. The claim has been treated as though "the" should have read "a".

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As was mentioned in the previous office action, data on a disk is not statutory unless that data is a data structure. A data structure causes a processor to manipulate data in a specific way. This definition is based upon *In re Lowry*. Please see MPEP 2106 IV B. 1. (b).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 9 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Naccache et al. (5434917).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-5, 7, 11-14, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naccache et al. in view of Knight et al. (5678863).

In their abstract, Naccache et al. teach reading a smart card for a medium mark, p, which anticipates applicant's first bitpattern. A second bitpattern, s, is made from p using a cryptographic digital signature algorithm, which includes a one-way function. The smart card has s recorded onto it, along with ID. The ID and card are authenticated using s.

Naccache et al. do not say that s is stored by being embedded within ID as a watermark. Although concerned with a more traditional type of watermark, Knight et al.'s abstract's disclosure that including a watermark within an identification region increases a document's security is applicable to Naccache et al. because both use watermark's that are based upon physical properties. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the medium identifying data of Naccache et al., s, within the identification, ID, as a watermark, thereby reaping the benefits taught by Knight et al.

Claim 4 is anticipated because the second bitpattern is formed using a public key algorithm. Public key cryptography identifies a signer. Claim 7 is met because the p is a product of physical characteristics, a prepressed mark, and some type of instructions that translate the physical characteristics into a bitpattern, which can be seen as a seed.

13. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naccache et al. and Knight et al. as applied to claim 5 above.

Naccache et al. and Knight et al. show a medium that is scanned to form an identification signature. They do not say that the scanned information can be written onto the medium. Official notice is taken that it is old and well-known to write identifying information onto a medium. Although the identifying information of Naccache et al. is a physical characteristic as opposed to a series of bits, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the security measures of Naccache et al., that is forming a signature from identifying data, on a record carrier that had had identifying information written onto it.

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naccache et al.

Naccache et al. show an information carrier that is scanned to form a signature, which is stored upon the information carrier. They do not say that the scanned information identifies a source of the information carrier and the stored data. Official notice is taken that including source and identification data within the building blocks of a digital signature is old and well known. This provides a redundancy check of the information carrier's owner as well as the authenticity of the signature. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include source and identification data within the building blocks of the digital signature.

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naccache et al. and Knight et al. as applied to claim 6 above.

Naccache et al. and Knight et al. show a medium that is scanned to form an identification signature. They do not say that the scanned information includes copy status information. Official notice is taken that it is old and well-known to engrave copy protection information on potentially recordable media. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for p to indicate the record carrier's copy protection status.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached between 9AM - 6PM, except for every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9052 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Douglas J. Meislahn
Examiner
Art Unit ~~2767~~ 2132

DJM
January 11, 2001

TOD SWANN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100